REMARKS/AGRUMENTS

In response to the above-identified Office Action, Applicant has amended the application and respectfully request reconsideration thereof.

Amendment of Claims

Claims 21 and 55 have been amended to include subject matter that places the claim within the technological arts, establishes a statutory class for the invention, and sets forth a useful, concrete and tangible result. Specifically, claims 21 and 55 are amended to require a system that stores information in a database and retrieves the information from the database. Support for these amendments may be found throughout the specification.

Claims 22, 24–32 have been amended in response to and consistent with the amendments of claim 21 and 55, respectively.

Claims 1 and 46 have been amended to include the limitations of claims 8 and 9.

Claim 21 has been amended to include the limitation of claim 23.

Claim 38 has been amended to include a limitation that includes substantially the same limitation of claim 9.

Claims 8, 9, 23 and 56 have been cancelled without prejudice.

Response to Claim Rejections – 35 USC § 101

Claims 21-32, 42, and 55-56 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

Applicant respectfully submits that claims 21-32, 42, and 55-56 should not be rejected under 35 U.S.C. § 101 for the reason that claims 21-32, 42, and 55-56, as amended, are directed towards statutory subject matter.

Claim 21, as amended, includes the following limitations:

> A system to store information in a database and to retrieve the information from the database, the system comprising:
>
> a first code corresponding to one aspect of a patient's health;
>
> a list of one or more definitions corresponding to the first code; and
>
> a first list of data sources obtained based upon the one or more definitions, wherein the first code, the list of one or more definitions and the first list of data sources are utilized to store information in the database and to retrieve information from the database; ...

Claim 21, as amended, requires a system that operates within the technological art of storing and retrieving information. Moreover, the recited system includes a database that utilizes components in the form of code, a list and a first list to store and retrieve information. Thus, the database imparts functionality to the components by facilitating storage and retrieval. Further, claim 21, as amended, characterizes an invention that produces a useful, concrete, and tangible result by providing access to

information otherwise inaccessible thereby achieving an effect that is both real and actual. Finally, claim 21, as amended, explicitly identifies the statutory class of the invention as a "system".

Independent claim 55 includes a limitation corresponding substantially to the above-discussed limitation of claim 21. Accordingly, Applicant requests that the above remarks and amendments contained herein also be considered when examining claim 55 for allowability.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 22-32 and 56 under 35 U.S.C. 101 is also addressed by the above remarks, and the amendments contained herein.

Claim 42, as amended, includes the following limitations:

The system of claim 38, wherein the first server includes a machine-readable medium comprising instructions which, when executed by a machine, cause the machine to perform operations, the instructions to comprise: ...

Thus, claim 42, as amended, includes limitations that are similar to those suggested by the examiner.

In summary Applicant respectfully submits that claims 21-32, 42, and 55-56 should not be rejected under 35 U.S.C. § 101 for the reason that claims 21-32, 42, and 55-56, as amended, are directed towards statutory subject matter.

Response to Claim Rejections – 35 USC § 102

Claims 1 and 46 stand rejected under 35 U.S.C. § 102(e) as being allegedly

anticipated by U.S. Patent No. 6,263,330 (hereinafter Bessette).

Applicant respectfully submits that claims 1 and 46 should not be rejected under

35 U.S.C. § 102(e) for the reason that Bessette does not disclose each and every

limitation of the claims 1 and 46, as amended, of the present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is
found, either expressly or inherently described, in a single prior art reference."

Claim 1, as amended, includes the following limitation:

selecting a set of existing queries that correspond to the received information
about the medical procedure.

The Office Action in rejecting this claim contends that the above limitation is

anticipated by the following disclosure in Bessette:

In short, the NDSMR record is data structure that contains two types of elements,
namely a collection of medical data elements about the individual and one or
more pointers ...these pointers adopt the URL (Universal Resource Locator)
addressing system, allowing to point to a specific file in a directory, where that
file and that directory can exist on any machine on the integrated health network
and can be served via any of several different methods...

Each pointer provides an address which may consist in the entire address
information of the file pointed to by the pointer or in a reference to the address

information, where the reference may be an index in a table that contains the address information. Associated directly with the pointer is a data field...

To facilitate the reading of the information associated with the pointers, namely the basic nature of the medical data, the display of the pointers may be organized
....

Bessette, Col. 13, line 23 – Col. 14, line 21 (first quote).

In accordance with this invention, the data structure of the pointer allows the workstation user, such as a doctor or consultant, to determine the general nature of the information to which the pointer is referring. In other words, the doctor can tell by simply looking at the pointer whether it points to is a medical document concerning a pulmonary x-ray, an electrocardiogram, allergy tests, etc.....

Bessette, Col. 13, line 1-38 (second quote).

The request is made on the basis of the particular patient's identifier, submitted to the NDSMR server at step 906. At step 908, the NDSMR is downloaded to the archivist's workstation, at which point the archivist is capable of modifying and updating certain sections of the data contained in the NDSMR, for instance the Significant Antecedents, Current Medical Condition and Links To Other Biological Data categories as seen in FIG. 6C. At step 910, the archivist refers to the updated list to update the NDSMR in order to reflect the individual's most recent and pertinent medical information, treatments and corresponding pointers. For example, assume that one of the archivist's list entries is that Mr. John Doe has undergone a new electrocardiogram at hospital E. The archivist will then change the Most Recent Electrocardiogram reference seen in the Links To Other Biological Data category of Mr. Doe's NDSMR to point to the Hospital E local network, more particularly to the file containing the digitized electrocardiogram.

Bessette, Col. 14, line 53 – Col. 15, line 3 (third quote).

Yet another feature of this invention is its use as a search/query engine. Not only can a user perform searches for or queries on NDSMRs within his/her own local Intranet, but also within external sources. NDSMR searches and queries may be performed on two different types of data, and therefore databases: nominative and non-nominative. .... In summary, the NDSMR system permits the delay-free

consultation of pertinent information found within different local files and, for authorized users, offers an integrated research motor which allows for non-nominative research, by object or by concept, on the whole of the accessible databases.

FIG. 10 displays the query usage allowed by the NDSMR system. From a client workstation, a user may make an initial query of the server 300. The server's DBMS and database logic allow the NDSMR database 302 to be searched rapidly and efficiently. The database logic is what allows the server to not only retrieve records on behalf of the client but also to perform searches on behalf of the client. We see in FIG. 10 that an initial query returned 300 possible NDSMRs. The system allows the user to send out a second, more narrow query, with a resulting 25 NDSMRs returned. The system is therefore very efficient, especially for massive searches performed across all accessible databases. In a most preferred embodiment of this invention, the query style offered by the workstation interface will be one of relational data searches, such as the style currently offered by the Alta Vista (Trade mark) web browser. The query style will not be described in detail as it is very well known to a person skilled in the art. Alternatively, many other query styles could be incorporated into the NDSMR search engine, for instance an object-oriented search style.

Bessette, Col. 15, line 25 – Col. 16, line 4 (fourth quote).

The above three quotes from Bessette describe various components, methods for retrieving information and methods for querying. The first quote from Bessette describes a Network Distributed Shared Medical Record (NDSMR) record that contains a collection of medical data elements and one or more pointers. The pointers are URLs and the URLs may be organized.

The second quote from Bessette describes a pointer that allows a workstation user, such as a doctor or consultant, to determine the general nature of the information

to which the pointer is referring. Thus, the pointer itself may indicate if the medical document concerns a pulmonary x-ray, an electrocardiogram, allergy tests, etc..

The third quote from Bessette describes an archivist that modifies and updates certain sections of the data contained in the NDSMR. The archivist maintains the most recent information for the patient.

The fourth quote from Bessette describes a feature of the invention whereby a user may perform queries on NDMSRs within a local Intranet or within external sources. The queries may be performed on different types of databases. The query style utilized is a relational data search, such as offered by the Alta Vista (Trade mark) web browser.

Claim 1 requires selecting a set of **existing queries** that correspond to received information about a medical procedure. For example, in one embodiment, the following query may be utilized to search for documents:

"http://www.XYZMed.com/cgibin/search?queryText=Thyroglobulin+Antibodies.

In contrast the first three quotes from Bessette do not describe a query; but rather, an NDMSR record that includes a URL (first quote), a pointer that indicates the general nature of the information to which the pointer is referring (second quote), and an archivist that modifies an NDSMR (third quote). Indeed, the fourth quote is the only quote that describes a query; however, the fourth quote describes a single query that is entered by a user. In contrast, claim 1 requires <u>selecting a set of existing queries</u> that

correspond to received information about a medical procedure. Clearly, a query that is entered by a user cannot constitute the selection of a set of preexisting queries. Bessette therefore cannot be said to anticipate the above quoted limitation because Bessette, at best, discloses a single query that is entered by a user and claim 1 requires selecting a set of existing queries that correspond to received information about a medical procedure.

In summary, Bessette does not disclose each and every limitation of claim 1, as required to support a rejection of this claim under 35 U.S.C. § 102(e).

Independent claim 46 includes a limitation corresponding to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of these independent claims. Accordingly, Applicant requests that the above remarks and amendments contained herein also be considered when examining these other independent claims for allowability.

Claim 55 stands rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 5,924,074 (hereinafter Evans).

Independent claim 55, as amended, includes a limitation corresponding to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of this independent claim.

In summary, Evans does not disclose each and every limitation of claim 55, as required to support a rejection of this claim under 35 U.S.C. § 102(e).

Response to Claim Rejections – 35 USC § 103

Claims 2-37 and 47-54 stand rejected under 35 U.S.C. § 103(a), as being allegedly

unpatentable over U.S. Patent No. 6,263,330 (hereinafter Bessette) in view of U.S. Patent

No. 5,924,074 (hereinafter Evans).

Applicant respectfully submit that claims 2-37 and 47-54 should not be rejected

under 35 U.S.C. § 103 for the reason that prior art references when combined do not

teach or suggest all of the claim limitations of the independent claims of the present

application.

> To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Independent claim 21 has been amended to include a limitation from dependent

claim 23 that corresponds to the above-discussed limitation of claim 1. The above

remarks are accordingly also applicable to a consideration of these independent claims.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 22 and 24-32 under 35 U.S.C. § 103 is also addressed by the above remarks.

Independent claim 33 includes an existing limitation that corresponds to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of this independent claim.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 34-37 under 35 U.S.C. § 103 is also addressed by the above remarks.

Dependent claims 47-49 depend upon independent claim 46. Independent claim 46 has been amended to include a limitation that corresponds to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of these dependent claims.

Independent claim 50 includes a limitation that corresponds to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of this independent claim.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 51-54 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Bessette in combination with Evans does not teach or suggest each and every limitation of claims 2-37 and 47-54 as required to support rejections of the independent claims of the present application under 35 U.S.C.§ 103.

Claims 38-45 and 56 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over Evans.

Applicant respectfully submits that claims 38-45 and 56 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

Independent claim 38 includes a limitation that corresponds to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of this independent claim.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 39-45 under 35 U.S.C. § 103 is also addressed by the above remarks.

Dependent claim 56 has been deleted.

In summary, Evans does not teach or suggest each and every limitation of claims 38-45 and 56 as required to support rejections of the independent claims of the present application under 35 U.S.C.§ 103.

In summary, Applicant believes that all rejections presented in the Office Action

has been fully addressed and withdrawal of these rejections is respectfully requested.

Applicant furthermore believes that all claims are now in a condition for allowance,

which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666.

If a telephone interview would in any way expedite the prosecution of the present

application, the Examiner is invited to contact Mark Vatuone at (408) 947-8200.

Respectfully submitted,

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Dated: _2/9_____, 2004

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